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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,063	09/16/2003	Yakov Beyrak	223829	2050
23460	7590	12/19/2005	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			NGUYEN, TUAN N	
		ART UNIT	PAPER NUMBER	
		3751		

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/663,063	BEYRAK, YAKOV
	Examiner Tuan N. Nguyen	Art Unit 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-39 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-32, 38 and 39 are objected to because of the following informalities: the limitations on lines 5-8 of claim 1 and on lines 5-7 of claim 38 are considered inaccurate since the retainer cannot prevent the spool from moving along the longitudinal axis as claimed and permit the spool to move along the longitudinal axis. The functions of preventing and then permitting seem to contradict each other. Furthermore, "the generally circular retainer" on line 11 of claim 38 lacks antecedent basis in the claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19-32, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the original specification on page 3, lines 8-12 discloses the retainer can be opened radially while still substantially limiting movement of the retainer along a longitudinal axis, it fails to provide support for the retainer disposed within the valve body so as to prevent the spool from moving along the longitudinal axis of the valve as claimed on lines 5-6 of claim 19 and lines

5-6 of claim 38. Claim 19 further claims "the retainer movable in a direction perpendicular to the longitudinal axis" on lines 6-7, which is not supported by the original specification. The expansion of the C-shaped retainer to an open position, as discloses on lines 8-12 of page 3, does not equate to the retainer being "movable in a direction perpendicular to the longitudinal axis" as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "a movable member" lacks antecedent basis in the specification, which cause the claim to be unclear as what structure the applicant is trying to claim since there are many members being disclosed in the specification.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Ensign.

Ensign discloses a valve having one or more ports and a longitudinal axis, the valve comprising a hollow valve body; a movable member (152) slidably disposed within

the valve body; a locking device (208) engageable to retain the valve in a selected position such that the movable member is restrained from moving axially relative to the valve (see col. 5, line 57 et seq.). The locking device is a hitch pin clip and wherein the valve body includes a first hole (one of the hole in 228 where pin 208 is positioned therethrough), and the movable member includes a groove defined between members (202) and (152), the groove of the movable member and the first hole of the valve body being positionable such that the groove and the hole are in axial alignment with each other to receive a portion of the hitch pin clip therethrough to retain the valve in the selected position (see Figs. 3 and 5), which is considered a neutral position of the valve. The valve body includes a second hole (the other hole in 228 where pin 208 is positioned therethrough) configured to accept a portion of the hitch pin clip therethrough for storing the hitch pin clip.

5. Claims 19-25, 30-32, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Loup.

In regard to claims 19-25, Loup discloses a valve having one or more ports and a longitudinal axis, the valve comprising a hollow valve body (12, 16, 18); a spool (38) slidably disposed within the valve body; a C-shaped retainer (58, 60 of Fig. 3) disposed within the valve body so as to prevent the spool from moving along the longitudinal axis of the valve, the retainer “movable in a direction perpendicular to the longitudinal axis” of the valve to an open position so as to permit the spool to move along the longitudinal axis of the valve; and a coupling member (44, 46) engaged with the spool, the coupling member having an engaging surface for engagement with the retainer such that the

spool is releasably retained in a first position (the position shown in Fig. 1 is considered as first neutral position) when the retainer is disposed in contacting relationship with the engaging surface. The engaging surface of the coupling member comprises an annular groove (about 54, see Fig. 2A). The valve body includes a recess (about 62 of Fig. 2A), the retainer disposed in the recess of the valve body, and the recess of the valve body being configured such that the retainer is substantially fixed relative to the longitudinal axis of the valve and is allowed to flex laterally along a direction perpendicular to the longitudinal axis. In response to the application of an opening force, the coupling member (44, 46) is movable relative to the retainer, the retainer thereby flexing outwardly to the open position and permitting the spool to move from the first position. The coupling member has a second annular groove (located in 44 instead of 46) for receiving the retainer such that the spool is releasably retained in a second position when the retainer is disposed within the second annular groove. The second position of the spool comprises a first flow path position of the valve.

In regard to claims 30-32, The Loup valve further comprises a locking device (62), which is considered as a hitch pin clip, engageable to retain the valve in the first neutral position.

In regard to claims 38 and 39, Loup discloses a valve having one or more ports, the valve comprising a hollow valve body (12, 16, 18); a spool (38) slidably disposed within the valve body such that the valve can move along a longitudinal spool axis; a retainer (58, 60 of Fig. 3) disposed so as to prevent the spool from moving along the longitudinal spool axis, the retainer movable to an open position so as to permit the

spool to move along the longitudinal spool axis; a coupling member (44, 46) slidably disposed within the valve body and coupled to the spool so as to move the spool, the coupling member having an annular groove (about 54, see Fig. 2A) for receiving the retainer; a guide member (about 70, 72 in Fig. 2) fixed within the valve body adjacent to the coupling member and with a small clearance to the retainer, such that when the coupling member is subjected to a force the retainer comes into contact with the guide member and the guide member prevent any further movement of the retainer along the longitudinal spool axis; a locking device (62), which is considered as a hitch pin clip, engageable with the guide member to retain the valve in a selected position.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loup in view of Meisel.

Although the Loup reference does not include second and third annular groove on a coupling member as claimed, attention is directed to the Meisel reference which discloses another valve having a coupling (34) with multiple grooves such as first, second, and third grooves to define multiple different flow path positions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was

made to employ, on the Loup device, a coupling with multiple grooves as, for example, taught by Meisel in order to provide more than one flow path position.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seger and Minor disclose other valves with safety pin locking device. Wilke and Overbeke disclose other spool valves.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tuan Nguyen  
Primary Examiner  
Art Unit 3751  
12/10/05

TN